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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/539,687	07/14/2005	Richard David Saunders	UDL27.001APC	8588
29995 7590 06/23/2009 KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614				
EXAMINER BURNEY, RACHEL L				
ART UNIT		PAPER NUMBER		
1795				
NOTIFICATION DATE		DELIVERY MODE		
06/23/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com  
eOAPilot@kmob.com

# Office Action Summary

## Application No.

10/539,687

## Applicant(s)

SAUNDERS ET AL.

## Examiner

Rachel L. Burney

## Art Unit

1795

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 9-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/02)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 9-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5427886, Miller et al. in view of US Patent 6051305, Hsu.

Miller discloses a process for forming an image comprising providing microcapsules in an aqueous manufacturing vehicle including enwrapped capsule core materials comprising a chromogen and a photosensitive composition, wherein the capsules are adhered to the surface of a substrate with a binder material, then the microcapsules are ruptured on the substrate allowing the chromogen to react with an acid developer (column 1, lines 36-60). The photosensitive composition may be a toner (column 6, lines 23-25), which would form a toner image. The chromogen may be 3,3-bis(4-dimethylaminophenyl)-6-dimethylaminophthalide (column 6, lines 45-67) which is the same security agent as the instant application and would therefore have the same properties, or mixtures of similar agents (column 7, lines 11-12). The acid developer may be treated clays, aromatic carboxylic acids or metal salts thereof, or phenolic resins

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(column 7, line 65 – column 8, line 7). The substrate may be paper (column 6, lines 1-10). Miller fails to teach the digital press system of the instant application. Hsu discloses digital presses (column 1, lines 20-26) which use liquid toners (column 5, lines 56-58). It would have been obvious to one of ordinary skill in the art at the time of the invention to use the any known imaging composition in the press of Hsu, including that of Miller, and one would have a reasonable expectation of success in doing so.

### ***Response to Arguments***

1. Applicant's arguments filed 04/09/2009 have been fully considered but they are not persuasive.

Applicant argues that Miller does not teach a reactant mixed with the toner composition and a complementary reactant carried by a substrate. The examiner respectfully disagrees. As stated in the previous action Miller teaches that the toner comprises a chromogen which reacts with an acid developer in the substrate. Therefore Miller does comprise a security agent (chromogen) which reacts with a complementary reactant (acid developer) which is carried by the substrate. Because these are the same chromogen and acid developer as those of the instant specification, it would be reasonable to conclude that the results of the reaction, such as a security feature with a "halo" effect would result from the reaction. Miller does incorporate the extra step of rupturing the toner particle, however the composition comprises all the required components.

Applicant argues that the combination of Hsu and Miller would render the process of Hsu unsatisfactory for its intended process. The examiner respectfully disagrees. Hsu discloses a process containing a liquid toner comprising fine particles to form a printed image, wherein the developed image is transferred and fused. Miller discloses forming an image by application of toner fine particles (column 2, lines 46-58). One of ordinary skill in the art would have a reasonable expectation of success in using any known imaging method using fine toner particles to form the image of Miller. Hsu is drawn to a fine toner particle image forming process, therefore one of ordinary skill in the art would have a reasonable expectation of success in using the method of Hsu.

### ***Conclusion***

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel L. Burney whose telephone number is (571)272-9802. The examiner can normally be reached on Mon-Thurs: 7:30-6:00 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark F. Huff/  
Supervisory Patent Examiner, Art Unit 1795

RLB